10-16-02

1646

CASE D0047 NP

#10/Rec
10-24-02

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EV001832257US	October 14, 2002
Express Mail Label Number	Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

FEDER ET AL.

APPLICATION NO: 09/992,238

FILED: NOVEMBER 14, 2001

FOR: A NOVEL HUMAN G-PROTEIN COUPLED RECEPTOR, HGPRBMY8, EXPRESSED HIGHLY IN BRAIN

Art Unit: 1646

Examiner: LI, RUIXIANG

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In reply to the Office Action dated September 12, 2002, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I drawn to a method of screening candidate compounds capable of modulating activity of a GPCR-encoded polypeptide, wherein the candidate compounds are small molecules.

The traversal is based, in part, on the belief that the Group I, II, and III claims will be held allowable once claims encompassing one of these Groups are allowed. Groups I, II, and III are all embraced by a common generic claim (Claim 23), and thus would be rendered allowable upon allowance of this generic claim (C.F.R. 1.141). Specifically, Groups I, II, and III are each embraced by a method of identifying a candidate compound capable of modulating the activity of the G-protein coupled receptor, HGPRBMY8, with Groups I, II, and III differing only in the type of molecule identified by the generic method, and not to distinct methods that are specific for the identification of each molecule type. Applicants acknowledge that small molecules, peptides, and antisense molecules are distinct compounds, and are subject to distinct classifications. However, Applicants do not believe such classifications should be used as a basis for restricting methods of identifying these compounds. Thus, there is no serious burden on the Examiner to examine the claims of Groups I, II, and III. Applicants also assert that generic claim 23 and dependent claims thereof may be used to identify other types of modulators of HGPRBMY8, and not just the restricted antisense, small molecule, and/or peptide modulators. Moreover, Applicants believe restriction to only one of these groups would unduly narrow the claim breadth Applicants should be entitled to receive. As a

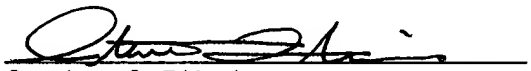
result, Applicants believe the Restriction Requirement is not proper and request that restriction amongst Groups I, II, and III be withdrawn.

Furthermore, since Groups I and II are classified in the same class and subclass, Applicants believe the Examiner would not encounter a serious burden in examining the claims of Groups I and II. At a minimum, Applicants respectfully request the restriction amongst Groups I and II be withdrawn.

The Office Action further directs that Applicants are required to elect a single disclosed species to which the claims would be restricted if no generic claim is finally held to be allowable and to list all claims readable thereon including those subsequently added. Applicants hereby provisionally elect, with traverse, the species of Group I containing a vector comprising the coding sequence of the beta lactamase gene under the control of NFAT response elements. Claims 23-26, 30-31, 34-36, 40-41, and 44-46 are readable thereon. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants response is timely and no extensions are necessary.

If any fee is due in connection herewith, please charge such fee to Deposit Account No. 19-3880 of the undersigned. Furthermore, if any extension of time not already accounted for is required, such extension is hereby petitioned for, and it is requested that any fee due for said extension be charged to the above-stated Deposit Account.

Respectfully submitted,



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Date: October 14, 2002